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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,395	06/20/2001	Delphine Coppens	55550US006	3952

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EXAMINER	
EGAN, BRIAN P	

ART UNIT	PAPER NUMBER
1772	6

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/885,395	COPPENS ET AL.	
	Examiner	Art Unit	
	Brian P. Egan	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-18 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-12 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 13-18 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Restriction Election

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-12, drawn to a label suitable for affixing to a garment, classified in class 428, subclass 325.

   II. Claims 13-18, drawn to a method of making a label, classified in class 427, subclass 163.4.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process. The adhesive layers need not be coated on one another. Instead, an extrusion or molding method may be incorporated. Furthermore, the substrate need not be heat activated when placed against a garment. The Substrate may instead be heat activated, then adhered to a substrate.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Stephen Jensen on September 13, 2002, a provisional election was made without traverse to prosecute the invention of group I, claims 1-12. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 13-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim recites the limitation, "wherein said first adhesive layer is capable of permanently bonding said backing layer to a garment when heated to a temperature between 100 and 180 degrees Celsius." Given that the label comprises a second adhesive layer on the side of the first adhesive layer opposite the backing layer, it is unclear how the first layer is permanently bonding the backing layer to the garment when there is an adhesive layer between the first adhesive layer

and the garment. The Examiner suggests replacing the aforementioned limitation by stating that the combination of the two adhesive layers or the second adhesive layer permanently bonds the backing layer to a garment. Proper clarification and/or correction are required.

8. Claims 1 and 8 are rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. The phrase, "suitable for," in the preamble is indefinite. The phrase, "suitable for," renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention, i.e., it is unclear whether the label is for a garment. The Examiner suggests rewording the claim such that it claims "a label for affixing to a _____." Wherein, _____, may be substituted with broad language such as "substrate," or more narrow language such as "garment." Proper clarification and/or correction are required.

9. Claim 4 is further rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention.

First, the phrase, "permanently bonding said backing layer to a garment when heated to a temperature between 100 and 180 degrees Celsius," is a process limitation and given no patentable weight in an article claim. The Examiner suggests rewording the temperature limitation such that it reads as a physical limitation of the adhesive layer, i.e., that the hot melt adhesive is activated at temperatures greater than 100 degrees Celsius. Proper clarification and/or correction are required.

Second, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bingham (#3,758,192) in view of Baker et al. (#4,166,152).

Bingham teaches a label for affixing to a garment ("fabrics"; Col. 1, lines 7-9) wherein the label comprises a backing layer (Fig. 7, #16), a first adhesive layer comprising a heat activatable adhesive (Fig. 7, #18), and a second heat activatable adhesive (Fig. 7, #28). The second adhesive layer is provided directly on the first adhesive layer (see Fig. 7). The backing layer has a first and second major side wherein one side is retroreflective (Fig. 7, #14) and the side opposite the retroreflective side carries the first and second adhesive layers (see Fig. 7). The first adhesive layer is non-tacky at temperatures less than 60 degrees Celsius ("layer is cured at 60 degrees Celsius"; Col. 8, line 3) and permanently bonds the backing layer to a garment when heated to a temperature between 85 and 160 degrees Celsius (Col. 10, lines 17-19). Both the first side of the backing layer and the outer surface of the second adhesive layer comprise removable layers protecting the label prior to affixing it to a substrate (Fig. 1, #10 and Fig. 7, #26,

respectively). The label further includes means for retroreflecting light carried by the side of the backing layer opposite the adhesive layers wherein the retroreflective means are selected from glass beads or microspheres (Col. 1, lines 9-10). Bingham does not explicitly state that the thickness of the second adhesive layer is between 10 and 40 micrometers although Bingham does teach that the first adhesive layer is 400 microns in thickness (Col. 7, lines 55-58) and that when the second adhesive layer is employed, a portion of the thickness of the first adhesive layer is replaced by the second adhesive layer (Col. 6, lines 23-29). Therefore, the thickness of the second layer implicitly falls within the range of 0 to 400 micrometers. Furthermore, it would have been obvious to one of ordinary skill in the art to have modified the thickness range of the second adhesive layer since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Bingham fails to teach the second adhesive layer comprising elastomeric microspheres.

Baker et al., however, teach that elastomeric microspheres ranging from 1 to 250 microns in size (Col. 4, lines 13-16) may be added to a hot melt adhesive for the purpose of providing a positionable hot melt adhesive system (Col. 4, lines 41-45). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made to have modified a label for affixing to a garment with microspheres in its outermost adhesive layer for the purpose of providing a positionable hot melt adhesive system as taught by Baker et al.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Bingham by dispersing microspheres within the

second hot melt adhesive layer as taught by Baker et al. in order to provide a positionable hot melt adhesive system. Such a modification is in line with the teachings of Bingham since Bingham teaches that the additional adhesive layer is used to help the common housewife to laminate the film to a fabric using a hand iron (Col. 6, lines 20-29). Therefore, Baker et al. would have been motivated to use a repositionable adhesive layer to further facilitate one in easily positioning the adhesive prior to ironing the substrate on to the desired end product.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 703-305-3144. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

BPE
September 27, 2002

HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

9/28/02